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09/742,980	12/20/2000	Ernst Held	10191/1674	8646

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EXAMINER

GILMAN, ALEXANDER

ART UNIT PAPER NUMBER

2833

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20

Application Number: 09/742,980
Filing Date: December 20, 2000
Appellant(s): HELD ET AL.

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GROUP 2800

Jong H. Lee for Richard L. Mayer

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/12/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims will be treated as a single group.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,234,817	Hwang	05-2001
6,358,67	Takase et al	03-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, 5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hwang.

Claims 3 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hwang in view of Takase et al

This rejection is set forth in prior Office Action, Paper No. 14.

(11) Response to Argument

With regard to claim 1, Appellants argue (Appeal, p. 6, lines 5-15) that the prior art (Hwang) fails to

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disclose "in inserted state the recess is set apart from the guide element". According to Appellants, the guide element (guiding rod – in Hwang) is fully within the recess (receptive passage – Hwang) is not set apart from the receiving passage.

Examiner respectfully disagrees with that statement. The phrase "the recess is set apart from the guide element" should be interpreted in sense that the respective elements are being kept separate (Heritage Dictionary, 4th Ed; Cambridge International Dictionary, 2nd Ed).

Even being fully within the recess, the guide element can be set apart from the recess if its cross-sectional size is smaller than that of the recess with the given tolerance. This interpretation corresponds to the idea of the invention (Fig. 3 of the Application; Appeal, p. 4, lines 4-8) where the guide (8) is separated from walls of the recess (9).

Meanwhile, in Hwang, the leading end of the guide element (24a) is located outside the recess (Fig. 4), not within the recess.

Hence, in Hwang, "in inserted state the recess is set apart from the guide element".

Appellants also argue (Appeal, p. 6, lines 16-31, p. 7, lines 1-10) that the section of Hwang (col. 2 lines 46-48 – recited by Examiner in the rejection) and the section (col. 1, lines 46-53 – recited by Appellants) do not suggest movement of the of plug connector with respect to the receptacle connector when both mated, but rather disclose that the plug connector moves or float with respect to the substrate.

However, the both above-mentioned recitations from Hwang clearly suggest " when the first (floatable) connector is mated to the corresponding second connector of the second substrate, the first (floatable) connector is moveable respect to the corresponding second connector". That movement, as it was shown in the rejection, is possible if the difference in the diameters of the recess (14) and the guide (24) is provided.

As for discussed in Appeal (Appeal, p. 7, lines 3-7) movement of the plug connector (20) regarding the substrate (41), that movement does not eliminate but complement the mutual movement of the plug and receptacle connectors when in mated position.

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Also, Appellants assume (Appeal, p. 7, line 11-29) that the phrase from the Examiner's Office Action, 12/17/2002, Response to Arguments --" ...movement is possible due to differences in diameter of the recess and the guiding element..." -- can be interpreted in the following way : "... the mounting pin (32) as being the guiding element and lug (31) as being the recess ...". Further (Appeal, p. 7, lines 23-29, p. 8, lines 1-20), Appellants show that the purported interpretation does not meet the claim limitations.

However, Examiner never suggested that interpretation. The rejection clearly refers to element (14) of Hwang as a recess and to element (24) as a guide element (Examiner's Office Action, 12/17/2002). Since that elements have no circular cross-section, the word "diameter", in the context of the rejection, has a meaning "cross-sectional size", "width" (Heritage Dictionary, 4th Ed.), not a diameter of the circle. Hence, the purported interpretation "... the mounting pin (32) as being the guiding element and lug (31) as being the recess ..." is not correct by definition.

In response to Appellants' argument (Appeal. p. 8. lines 21-26; p.9, lines 1-19) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, while Hwang (the primary reference) does not suggest the cam, round configuration of the guide element, that configuration is generally available in the art (the rejection used Takase (the secondary reference), as an example). It is common in the art to make the rounded perimeter of the guide element to provide a smooth communication of the guide with the communicating recess.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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August 29, 2003

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